

COPY

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application for Reissue of U.S. Patent No. 5,601,997

Applicant(s): Tchao, R.

Examiner: Wong, L. (Anticipated)

Serial No.:

Group Art Unit: 1302 (Anticipated)

Filed:

Docket: 102-302 Re

For: Chemotaxis Assay

Dated: September 23, 1998

Assistant Commissioner for Patents
Washington, DC 20231

REISSUE DECLARATION

Sir:

I, Ruy Tchao, declare that I am a citizen of the United States and a resident of Flourtown, Pennsylvania, and:

that I believe that I am the original and first sole inventor of the subject matter claimed in U.S. Patent No. 5,601,997 (hereinafter the '997 patent), entitled "Chemotaxis Assay Procedure";

that I have reviewed and understand the specification of the accompanying reissue application, including the claims;

that I believe that I am the original and first sole inventor of the subject matter which is claimed and for which a reissue patent is sought; and

that I acknowledge my duty to disclose to the U.S. Patent Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56.

I further declare that I believe the above-identified original patent to be partly inoperative or invalid by reason of my claiming less than I had a right to claim in the original patent.

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Specifically, I believe that the original patent is partly inoperative or invalid for including limitations in the claims which were not required by the prior art.

During the course of negotiations to license certain of my rights in the '997 patent to Becton Dickinson and Company (hereinafter "Becton") certain limitations in the claims thereof came to my attention. In particular, after reviewing the specification and issued claims of U.S. Patent No. 5,601,997 and consulting with patent attorneys at Becton and the law firm of Hoffmann & Baron, LLP, who are outside patent counsel for Becton, I came to the realization that I had inadvertently failed to claim certain broad aspects of my invention.

I believe that the error constituted inadvertent failure to appreciate the full scope of claims which were available in view of the prior art, and that the error arose without any deceptive intention on my part.

Claim 16 of the reissue application corresponds generally with claim 1 of the '997 patent. Claim 16, however, differs from claim 1 in at least one respect including, for example:

The limitation "relating to the use of a radiation opaque membrane" included in claim 1 does not appear in claim 16. Claim 16 additionally recites the use of a "permeable, detection blocking membrane". No art was cited against this claim 1 by the Examiner.

These and other limitations in claim 1 resulted from the apparent failure of myself and prior patent counsel to fully appreciate the limiting nature of the claim limitations, as well as failure to fully appreciate the full scope of the invention as taught by the specification.

In the course of attempting to license my patent to Becton, I was advised by Becton's outside counsel of the narrow scope of coverage to which the '997 patent may be entitled as a result of such limitations. During prosecution of the application, I did not fully realize or

appreciate the effect of these limitations on the scope of coverage provided by the resulting patent.

I have always felt that a significant aspect of my invention is its applicability to any assay which lends itself to the use of a permeable, detection blocking membrane for detecting and/or identifying and/or quantifying biological material present on one side of the membrane but without detecting/identifying/quantifying biological material that has not crossed the membrane. Furthermore, I have always believed that another significant aspect of my invention was to provide an assay that was substantially non-destructive of the biological material that was being detected/identified/quantified notwithstanding the nature of the assay. Through inadvertent error, none of the claims of the '997 patent either as originally submitted or as allowed, claim these specific aspects of my invention.

Furthermore, all errors being corrected in the present reissue application arose without any deceptive intention on my part.

I declare that all statements made herein of my own knowledge are true, and that all statements made upon information and belief are believed to be true, and further that these statements were made after being warned that wilful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such false statements may jeopardize the validity of this application or any patent issuing thereon.

Full name of sole or first inventor Ruy Tchao, Ph.D.

Inventor's Signature

Ruy Tchao

Date

Sept. 21, 1998

Residence 404 Cedar Lane, Flourtown, PA 19031 Citizenship U.S.A.

Post Office Address _____

PATENT

Please transfer the drawings from original patent, 5,601,997, filed on February 3, 1995, for the invention entitled Chemotaxis Assay Procedure

☒ is attached hereto.

☐ was filed on _____, as reissue application number /

K. Han

Signature of practitioner

Date: September 22, 1998

Kevin C. Hooper

(type or print name of practitioner)

HOFFMANN & BARON, LLP

350 Jericho Turnpike

Jericho, NY 11753

P.O. Address

(973) 331-1700

Reg. No.: 40,402

Tel. No.

Customer No.:

[illegible]

Request for Transfer of Drawings from Original Patent to Reissue Application [17-9]

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REISSUE APPLICATION BY THE INVENTOR, OFFER TO SURRENDER
(37 C.F.R. § 1.178)

To the Assistant Commissioner for Patents:

1: The undersigned applicant of the accompanying reissue application for the reissue of letters patent for the improvement in Chemotaxis Assay Procedure
Patent number 5,601,997 granted to him/her on February 11, 1997, of which

☒ he/she is now sole owner,☐

is now sole owner by assignment, and on whose behalf and with whose assent the accompanying application is made,

☐ The "ASSENT BY THE ASSIGNEE" to this reissue application is attached.

Date:

9/21/98

Signature(s)

Ruy Tchao

(type or print name(s))

CERTIFICATION UNDER 37 C.F.R. § 1.10*

(Express Mail label number is mandatory.)

(Express Mail certification is optional.)

I hereby certify that this correspondence and the documents referred to as attached therein are being deposited with the United States Postal Service on this date 9/23/98 in an envelope as "Express Mail Post Office to Addressee," service under 37 C.F.R. § 1.10, Mailing Label Number E1356061016US addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

(type or print name of person mailing paper)

Signature of person mailing paper

WARNING: Certificate of mailing (first class) or facsimile transmission procedures of 37 C.F.R. § 1.8 cannot be used to obtain a date of mailing or transmission for this correspondence.

***WARNING:** Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. § 1.10(b).

"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

(Reissue Application by the Inventor, Offer to Surrender (37 C.F.R. § 1.178)—Assent of Assignee
[17-2]—page 1 of 2)

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REISSUE APPLICATION DECLARATION AND POWER OF ATTORNEY
(BY INVENTOR(S) OR ASSIGNEE)

(complete A or B)

COPY

A. ☒ DECLARATION BY THE INVENTOR(S)

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name, I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter that is described and claimed in letters patent number 5,601,997, granted on February 11, 1997, and for which invention I solicit a reissue patent on the invention entitled Chemotaxis Assay Procedure

the specification of which

☒ is attached hereto.☐ was filed on _____, as reissue application number / and was amended on _____ (if applicable).☒ I hereby declare that there is no assignee for this application.

NOTE: "Where no assignee exists, applicant should affirmatively state that fact. If the file record is silent as to the existence of an assignee, it will be presumed that no assignee exists." M.P.E.P., 6th ed., rev. 1, § 1410.01.

B. ☐ DECLARATION BY ASSIGNEE

NOTE: The assignee of the entire interest may make the declaration, if the reissue application does not seek to enlarge the scope of the claims of the original patent. 37 C.F.R. § 1.172.

(type or print name of declarant)

Title

of _____

Name of company or legal entity on whose behalf declarant is authorized to sign

declare that I am a citizen of _____ and resident of _____

_____, that the entire title to letters patent number _____

for _____

granted on _____, 19____ to _____

Inventor(s)

is vested in _____

Name of company or legal entity

that I believe said named inventor(s) to be an original, first and sole inventor (if only one name is listed) or an original, first and part inventor (if plural names are listed) of the subject matter that is described and claimed in the aforesaid letters patent and in the foregoing specification and for which invention I solicit a reissue patent.

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ACKNOWLEDGEMENT OF REVIEW OF PAPERS AND DUTY OF CANDOR
(37 C.F.R. § 1.175)

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information that is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56.

- ☒ In compliance with this duty, there is attached an information disclosure statement in accordance with 37 C.F.R. § 1.98.

PRIORITY CLAIM

NOTE: A "claim" for the benefit of an earlier filing date in a foreign country under 35 U.S.C. 119(a)-(d) must be made in a reissue application even though such a claim was made in the application on which the original was granted. However, no additional certified copy of the foreign application is necessary. M.P.E.P., 6th ed., rev. 1, § 1417.

I hereby claim foreign priority benefits under Title 35, United States Code, § 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

(complete C or D)

- C. ☒ No such applications have been filed.
D. ☐ Such applications have been filed as follows:

**EARLIEST FOREIGN APPLICATION(S), IF ANY FILED WITHIN 12 MONTHS
(6 MONTHS FOR DESIGN) PRIOR TO SAID APPLICATION**

Country	Application No.	Date of filing (day, month, year)	Date of issue (day, month, year)	Priority Claimed
				<input type="checkbox"/> YES NO <input type="checkbox"/>
				<input type="checkbox"/> YES NO <input type="checkbox"/>
				<input type="checkbox"/> YES NO <input type="checkbox"/>

**ALL FOREIGN APPLICATION(S), IF ANY FILED MORE THAN 12 MONTHS
(6 MONTHS FOR DESIGN) PRIOR TO SAID APPLICATION**

BENEFIT OF PROVISIONAL APPLICATION

0642490-12460

POWER OF ATTORNEY

I hereby appoint the following practitioner(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

Charles R. Hoffmann, Reg. No. 24,102; Ronald J. Baron, Reg. No. 29,281; Gerald T. Bodner, Reg. No. 30,449; Alan M. Sack, Reg. No. 31,874; A. Thomas Kammer, Reg. No. 28,226; Arlene D. Morris, Reg. No. 32,657; R. Glenn Schroeder, Reg. No. 34,720; Glenn T. Henneberger, Reg. No. 36,074; Livia Boyadjian, Reg. No. 34,781; Jessica H. Tran, Reg. No. 40,842; Irving N. Feit, Reg. No. 28,801; Anthony E. Bennett, Reg. No. 40,910; Gregory A. Bachmann, Reg. No. P41,593; Steven T. Zuschlag, Reg. No. P43,309; Susan A. Sipos, Reg. No. P43,128; William D. Schmidt, Reg. No. 39,492; and Kevin E. McDermott each of them of HOFFMANN & BARON, 350 Jericho Turnpike, Jericho, New York 11753; and Daniel A. Scola, Jr., Reg. No. 29,855; Salvatore J. Abbruzzese, Reg. No. 30,152; Kirk M. Miles, Reg. No. 37,891; Kevin C. Hooper, Reg. No. 40,402; and Robert F. Chisholm, Reg. No. 39,939, each of them of HOFFMANN & BARON, 1055 Parsippany Boulevard, Parsippany, New Jersey 07054.

(check the following item, if applicable)

- ☐ I hereby appoint the practitioner(s) associated with the Customer Number provided below to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.
- ☐ Attached, as part of this declaration and power of attorney, is the authorization of the above-named practitioner(s) to accept and follow instructions from my representative(s).

SEND CORRESPONDENCE TO

- ☒ Address
HOFFMANN & BARON, LLP
350 Jericho Turnpike
Jericho, NY 11753

DIRECT TELEPHONE CALLS TO: (Name and telephone number)

Kevin C. Hooper
973-331-1700

- ☐ Customer Number _____

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DECLARATION

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Signature(s)

☒ **BY THE INVENTOR(S)**

Full name of sole or first inventor Ruy Tchao

Inventor's signature Ruy Tchao

Date Sept. 21, 1998 Country of Citizenship U.S.

Residence 404 Cedar Lane, Flourtown, PA 19031

Post Office Address Same as Above

Full name of second joint inventor, if any _____

Inventor's signature _____

Date _____ Country of Citizenship _____

Residence _____

Post Office Address _____

☐ **BY ASSIGNEE OR PERSON AUTHORIZED TO SIGN ON BEHALF OF ASSIGNEE**

NOTE: Even though inventor(s) do not sign, complete above information for inventor(s).

(complete the following, if applicable)

(type name of assignee)

Address of assignee

Title of person authorized to sign on behalf of assignee

☐ Assignment recorded in PTO on _____

Reel _____

Frame _____

☐ A separate ☐ "ASSIGNMENT (DOCUMENT) COVER SHEET"
or ☐ FORM PTO 1595 is submitted herewith along with the assign-
ment _____

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SECRET